

REMARKS

In response to the Office Action dated August 23, 2007, Applicants respectfully request reconsideration based on the following remarks. Applicants respectfully submit that the claims as presented are in condition for allowance.

Claims 1, 3-5, 8, 10, 11, 13-16, 21-25, 28, 32-35 and 37 were rejected under 35 U.S.C. § 103 as being unpatentable over Frech in view of Henningson. This rejection is traversed for the following reasons.

Claim 1 recites “replacing a telephone directory number associated with the services node with a telephone directory number associated with the first telephone station.” Frech does not teach this feature. Frech uses both the calling party number and the directory number of the SCN/IP to obtain call processing instructions when terminating a call (e.g., Figure 3, step12). The Examiner reasons that it is inherent in Frech to replace the directory number of the SCN/IP with that of the calling party station. Applicants respectfully disagree that this feature is inherent in Frech.

To perform the caller ID function in Frech, recorded announceable data is provided to the called party when the called party accepts a call. There is no need to replace the directory number of SCN/IP with that of the first telephone station, as the directory number is not used in the caller identification processing at the called party station. A pre-recorded audible announcement is used, not the directory phone number.

As noted in MPEP § 2112, “to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” In the present case, there is no evidence that Frech “necessarily” replaces the SCN/IP directory number with the directory number of the originating caller. Since Frech does not use the directory number for caller ID, but rather uses recorded audio, there is no need to replace the SCN/IP number. Clearly this feature is not “inherent” in Frech, either factually or legally.

Henningson was relied upon for teaching visual caller identification information, but fails to cure the deficiencies of Frech discussed above. Further, based on the teachings of Frech, it would not have been obvious to modify Frech to include visual caller identification as taught by Henningson. Frech clearly teaches against visual caller ID systems. Column 1, lines 26-35 read as follows.

A disadvantage of regular calling number/name identification is that it requires special equipment to display the number or name at any receiving telephone station. This disadvantage is overcome in accordance with the teachings of U.S. Pat. No. 4,899,358 (the '358 patent) which discloses arrangements for announcing a name or number for an incoming call, and U.S. Pat. No. 5,007,076 (the '076 patent) which discloses arrangements for announcing a name or number for a waiting call to a party who has call waiting service. The announcement is receivable on any telephone instrument without requiring the special display equipment.

Frech teaches against visual caller identification systems because they require display equipment at the receiving telephone station. As noted in MPEP § 2145, it is improper to combine references where the references teach away from their combination. In the present case, Frech clearly teaches against visual caller ID. The Examiner's proposed combination of Frech and Henningson is against the express teaching of Frech, and thus is improper.

For at least the above reasons, claim 1 is patentable over Frech in view of Henningson. Claims 3-5, 8 and 10 variously depend from claim 1 and are patentable over Frech in view of Henningson for at least the reasons advanced with reference to claim 1.

Claims 11 and 21 recite features similar to those discussed above with reference to claim 1 and are patentable over Frech in view of Henningson for at least the reasons advanced with reference to claim 1. Claims 13-16 depend from claim 11 and are considered patentable for at least the same reasons. Claims 22-25, 28, 32-35 and 37 depend from claim 21 and are considered patentable for at least the same reasons.

Further, it is noted that claim 28 depends from claim 27. Claim 27 was rejected based on Frech in view of Henningson and Madoch. It is not clear how claim 28 can be rejected based on Frech in view of Henningson, when claim 27 (upon which claim 28 depends) was rejected based on Frech in view of Henningson and Madoch. Thus, the rejection of claim 28 is flawed and should be withdrawn. The Examiner is reminded that any

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new grounds of rejection of claim 28 shall be non-final as Applicants have not amended claim 28.

Claims 6 and 35 were rejected under 35 U.S.C. § 103 as being unpatentable over Frech in view of Henningson and Devillier. This rejection is traversed for the following reasons. Devillier was relied upon for allegedly disclosing connecting a first telephone station with a voice mail of a second telephone station, but fails to cure the deficiencies of Frech in view of Henningson discussed above with reference to claims 1 and 21. Claim 6 depends from claim 1 and is patentable over Frech in view of Henningson and Devillier for at least the reasons advance with reference to claim 1. Claim 35 depends from claim 21 and is patentable over Frech in view of Henningson and Devillier for at least the reasons advance with reference to claim 21.

Claim 7 was rejected under 35 U.S.C. § 103 as being unpatentable over Frech in view of Henningson and Griffiths. This rejection is traversed for the following reasons. Griffiths was relied upon for allegedly disclosing playing a ringing tone to the first telephone station, but fails to cure the deficiencies of Frech in view of Henningson discussed above with reference to claim 1. Claim 7 depends from claim 1 and is patentable over Frech in view of Henningson and Griffiths for at least the reasons advance with reference to claim 1.

Claims 9, 17 and 27 were rejected under 35 U.S.C. § 103 as being unpatentable over Frech in view of Henningson and Madoch. This rejection is traversed for the following reasons. Madoch was relied upon for allegedly disclosing querying a second service control point for information associated with the first telephone station, but fails to cure the deficiencies of Frech in view of Henningson discussed above with reference to claims 1, 11 and 21. Claim 9 recites features similar to those discussed above with reference to claim 1 and is patentable over Frech in view of Henningson and Madoch for at least the reasons advanced with reference to claim 1. Claim 17 depends from claim 11 and is patentable over Frech in view of Henningson and Madoch for at least the reasons advance with reference to claim 11. Claim 27 depends from claim 21 and is patentable over Frech in view of Henningson and Madoch for at least the reasons advance with reference to claim 21.

Claim 12 was rejected under 35 U.S.C. § 103 as being unpatentable over Frech in view of Henningson and Malik. This application was filed after November 29, 1999 entitling 00124 (BLL-0476)

this application to the benefits of 35 U.S.C. § 103(c). Applicants assert that the subject matter of this application and Malik were, at the time of the invention of the subject matter of this application, owned by the same party or subject to an obligation of assignment to the same party, namely BellSouth Intellectual Property Corporation. Accordingly, under 35 U.S.C. § 103(c), Malik cannot be applied as prior art against this application. Claim 12 has not been amended, and thus any subsequent rejection of claim 12 must be non-final.

Claims 18-20 and 29-31 were rejected under 35 U.S.C. § 103 as being unpatentable over Frech in view of Henningson and Bossemeyer. This rejection is traversed for the following reasons. Bossemeyer was relied upon for allegedly disclosing converting textual information to text-to-speech format, but fails to cure the deficiencies of Frech in view of Henningson discussed above with reference to claims 11 and 21. Claims 18-20 depend from claim 11 and are patentable over Frech in view of Henningson and Bossemeyer for at least the reasons advance with reference to claim 11. Claims 29-31 depend from claim 21 and are patentable over Frech in view of Henningson and Bossemeyer for at least the reasons advance with reference to claim 21.

Claim 23 was rejected under 35 U.S.C. § 103 as being unpatentable over Frech in view of Henningson and Dugan. This rejection is traversed for the following reasons. Dugan was relied upon for allegedly disclosing detecting DTMF tones, but fails to cure the deficiencies of Frech in view of Henningson discussed above with reference to claim 21. Claim 23 depends from claim 21 and is patentable over Frech in view of Henningson and Dugan for at least the reasons advance with reference to claim 21.

Claims 26 and 38 were rejected under 35 U.S.C. § 103 as being unpatentable over Frech in view of Henningson and Cox. This rejection is traversed for the following reasons. Cox was relied upon for allegedly disclosing a database having at least 50 characters of data associated with the first telephone station, but fails to cure the deficiencies of Frech in view of Henningson discussed above with reference to claims 1 and 11. Claim 26 depends from claim 21 and is patentable over Frech in view of Henningson and Cox for at least the reasons advance with reference to claim 21. Claim 38 depends from claim 1 and is patentable over Frech in view of Henningson and Cox for at least the reasons advance with reference to claim 1.

Claim 36 was rejected under 35 U.S.C. § 103 as being unpatentable over Frech in view of Henningson and Devillier and Griffiths. This rejection is traversed for the following reasons. Griffiths was relied upon for allegedly disclosing playing a ringing tone to the first telephone station, but fails to cure the deficiencies of Frech in view of Henningson and Devillier discussed above with reference to claim 35. Claim 36 depends from claim 35 and is patentable over Frech in view of Henningson and Devillier and Griffiths for at least the reasons advance with reference to claim 35.

In view of the foregoing remarks and amendments, Applicants submit that the above-identified application is now in condition for allowance. Early notification to this effect is respectfully requested.

If there are any charges with respect to this response or otherwise, please charge them to Deposit Account 06-1130.

Respectfully submitted,

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